Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte SUEHIRO HASSHI,
TOSHIKI TAKAHASHI,
and
TOSHIYA HASEGAWA

_____

Appeal No. 2001-0436
Application No. 09/040,361

_____

HEARD: APRIL 26, 2001

_____

Before CALVERT, COHEN, and STAAB, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claims 1-3, 5 and 6 as amended by an amendment filed subsequent to the final rejection. No other claims are currently pending in the application.

Appellants' invention pertains to "an engine room arrangement for a vehicle, and in particular to an engine room arrangement having a controlled crush zone" (specification, page

1). Claim 1, a copy of which can be found in the appendix to appellants' main brief, is representative of the appealed subject matter.

The sole reference relied upon by the examiner in support of the anticipation rejection made in the final rejection is:

Moriyama et al. (Moriyama) 5,040,634 Aug. 20, 1991

Claims 1-3, 5 and 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Moriyama.[1]

Reference is made to appellants' main and reply briefs (Paper Nos. 13 and 16) and to the examiner's answer (Paper No. 14) for the respective positions of appellants and the examiner regarding the merits of this rejection.

Discussion

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. *In re Venezia*, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976). Furthermore, in order to satisfy the second paragraph of 35 U.S.C. § 112, a claim must accurately

[1]In light of the amendment filed subsequent to the final rejection, the examiner has withdrawn the rejection of the appealed claims under 35 U.S.C. § 112, second paragraph. See the advisory letter mailed March 13, 2000 (Paper No. 10).

define the claimed subject matter in the technical sense. *See In re Knowlton*, 481 F.2d 1357, 1366, 178 USPQ 486, 492 (CCPA 1973). While the claim language may appear, for the most part, to be understandable when read in the abstract, no claim may be read apart from and independent of the supporting disclosure on which it is based. *In re Cohn*, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971); *In re Moore*, 439 F.2d 1232, 1235 n.2, 169 USPQ 236, 238 n.2 (CCPA 1971). Applying these principles to the present case, we have encountered considerable difficulty understanding the meaning of several terms appearing in the appealed claims.

Our first difficulty concerns appellants' use of the word "under" in the last paragraph of claim 1, as in "said engine assembly comprises an engine unit and a transmission unit which is disposed *under* said engine unit" (emphasis added). While the quoted claim language may appear to be clear when read in a vacuum, this claim language, when read in light of the supporting specification, and especially the drawing figures, raises an unreasonable degree of uncertainty as to what the word "under" may mean. In this regard, *Webster's Dictionary*[2] indicates that

[2]I.e., *Webster's II New Riverside University Dictionary*, the Riverside Publishing Company, copyright © 1984 by Houghton Mifflin Company.

the word "under" may mean "beneath the surface of." However, appellants' transmission unit 10 as shown in Figure 1 is not vertically aligned with engine unit 1, but rather offset to the right of the engine unit. This being the case, it is not clear how the transmission unit 10 can be "under" (i.e., beneath) the engine unit 1 based on the above noted commonly accepted definition of "under." While appellants may have intended the word "under" to have a specialized meaning within the context of the present invention, it is not clear what that specialized meaning might be. Accordingly, when the claim terminology "said engine assembly comprises an engine unit and a transmission unit which is disposed under said engine unit" is read in light of its supporting specification, we are left to speculate as to precisely what the word "under" appearing therein may mean.

Another instance of claim terminology whose meaning is not clear is found in the last paragraph of claim 1, which calls for a transmission unit projecting rearward toward a passenger compartment of the vehicle body and forming a recess "between an upper portion of said engine unit and said transmission unit." As shown in Figure 1, appellants' transmission unit 10 is not in vertical alignment with engine unit 1, and in particular the intake manifold 8 thereof, but rather offset to the right of the

engine unit and the intake manifold. Based on this disclosed relationship, and *Webster's Dictionary*[3] definition of "between" as meaning "in the interval or position separating," it is inaccurate to describe the unnumbered space situated to the right of the steering gear unit 14 (as viewed in Figure 3) as a recess formed between the upper portion of the transmission unit 10 and the upper portion (i.e., the intake manifold 8) of the engine unit, as now claimed.

While we might speculate as to what is meant by the claim language discussed above, our uncertainty provides us with no proper basis for making the comparison between that which is claimed and the prior art, as we are obligated to do. Rejections based on 35 U.S.C. § 102(b) and/or 35 U.S.C. § 103 should not be based upon "considerable speculation as to [the] meaning of the terms employed and assumptions as to the scope of [the] claims." *See In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become anticipated or obvious, but rather the claim becomes indefinite. *See In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA

[3] *Id.*

1970). Accordingly, we are constrained to reverse the examiner's rejection of claims 1-3, 5 and 6 under 35 U.S.C. § 102(b) as being anticipated by Moriyama. We hasten to add that this is a procedural reversal that is not based upon any evaluation of the merits of the rejection, and does not preclude the examiner's advancement of a rejection predicated upon Moriyama against a definite claim.

New Ground of Rejection

Pursuant to 37 CFR § 1.196(b), we enter the following new rejection.

Claims 1-3, 5 and 6 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter sought to be patented. The meaning of the word "under" in the requirement of claim 1 that "said engine assembly comprises an engine unit and a transmission unit which is disposed under said engine unit" is unclear when the claim terminology is read in light of the supporting specification and drawings. In addition, the requirement of claim 1 that the transmission unit "forms a recess between an upper portion of said engine unit and said transmission unit" is unclear in that it is inaccurate.

Summary

The decision of the examiner rejecting claims 1-3, 5 and 6 as being anticipated by Moriyama is reversed on procedural grounds.

A new ground of rejection of claims 1-3, 5 and 6 has been made pursuant to 37 CFR § 1.196(b).

The decision of the examiner is reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner . . . .

> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record . . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

IAN A. CALVERT Administrative Patent Judge	)	
IRWIN CHARLES COHEN Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LAWRENCE J. STAAB Administrative Patent Judge	)	

LJS:hh

ARMSTRONG, WESTERMAN,
HATTORI, McLELAND & NAUGHTON
1725 K Street, N.W.
Washington, DC 20006